UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,704	02/25/2000	Tuomo Hokkanen	2132-25PCON	7280

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EXAMINER
NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/513,704	HOKKANEN ET AL.
	Examiner	Art Unit
	Andrew L Nalven	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2004*.

2a)☒ This action is **FINAL.**　　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,8-18* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *15* is/are allowed.

6)☒ Claim(s) *1,3-6,8-14 and 16-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-18 are pending.

2.   The amendment submitted on 9/14/2004 has been received and entered.

Response to Arguments

3.   Applicant's arguments filed 14 September 2004 have been fully considered but they are not persuasive.

4.   Applicant has argued on page 10 that the Heinz reference fails to teach "selecting from the stored set of expendable passwords, automatically by the terminal device at user log-on to the service, one of the stored passwords for use in logging on to the service" and "transmitting the selected password to the server by adding the selected password to a connection setup signal transmitted from the terminal device to the server via the network to remotely log-on to the service from the terminal device of the user" as recited in claims 1 and 6. Examiner notes that in the non-final rejection mailed 6/14/04, the Nielsen reference was relied upon to teach these limitations. Examiner maintains that the combination of Heinz and Nielson teaches the "selecting from the stored set of expendable passwords, automatically by the terminal device at user log-on to the service, one of the stored passwords for use in logging on to the service" (Nielsen, column 3 line 64 – column 4 line 8). Nielson teaches the client automatically selecting a password and using it to log to a service (Nielson, column 4

lines 3-4, decrypting and forwarding the needed password). Examiner further contends

that the combination of Heinz and Nielson teaches "transmitting the selected password

to the server by adding the selected password to a connection setup signal transmitted

from the terminal device to the server via the network to remotely log-on to the service

from the terminal device of the user" (Nielson, column 4 lines 3-4). Applicant has further

argued this point on Page 10 by alleging that Heinz teaches initially sending a

connection setup signal without a password. Examiner notes that the term "connection

setup signal", as provided in claims 1 and 6, does not require that the signal be the first

or initial communication between the server and terminal. Given its broadest possible

interpretation, the term "connection setup signal" comprises any signal sent between the

terminal and server for use in setting up a connection. Thus, the Nielson reference

does teach a connection setup signal including a password (Nielson, column 4 lines 3-4,

decrypting and forwarding the needed password).

5.   Applicant has further argued on page 10 that Heinz fails to teach or suggest the

use of single-use passwords and registering the selected password as "used" at the

terminal device. Examiner respectfully disagrees. Heinz does teach the use of single-

use passwords by proposing an embodiment where passwords are not re-used (Heinz,

column 6 line 44, column 7 lines 10-12) thus preventing repeated use of a password.

Further, in discussing alternate embodiments, Heinz states "If passwords are used more

than once," further suggesting that passwords may only be used once (Heinz, column 6

line 61). Heinz further teaches the registering of selected passwords as used (Heinz,

column 6 line 66 – column 7 line 4) by teaching two lists where unused passwords are

place in a first list and used passwords are placed in a second list

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Heinz US Patent No. 5,812,764 in view of Nielsen US Patent No 6,006,333. Heinz

discloses a password management system over a communications network. Nielsen

teaches a password helper for presenting appropriate client passwords to remote

servers.

8.   With regards to claims 1 and 6, Heinz discloses providing the user of a service

with a set of single-use passwords for remotely accessing a service via a network

(Heinz, column 4, lines 1-4 and column 6, lines 44-52, column 7 lines 10-13) and the

storing of the provided passwords on the terminal device of the user (Heinz, column 4,

lines 8-13). A connection is set up via the network from the terminal to the server to

enable use of the service (Heinz, column 5, lines 34-46). Heinz further discloses the

receiving of a setup signal and the validation of the password at the server for either

allowing or denying access (Heinz, column 6, lines 1-12) and the registering of the

selected password as used at the terminal device to thereby prevent unintended reuse

of a used password (Heinz, column 6 line 66 – column 7 line 16). Heinz lacks a

reference to the terminal automatically selecting from the stored set of expendable

passwords and transmitting the password as a portion of a connection setup signal.

Nielsen discloses the selecting from the stored set of passwords, automatically by the

terminal device at user log-on, one of the stored passwords for use in logging on to the

service (Nielsen, column 3 line 64 – column 4 line 8). At the time the invention was

made, it would have been obvious to a person of ordinary skill in the art to utilize

Nielsen's method of using a terminal selected password as a portion of a setup signal

with Heinz's password management system because it offers the advantage of allowing

authentication to a plurality of services without the user having to enter a password for

each access to the plurality of remote servers (Nielsen, column 1, lines 31-55).

9.   With regards to claims 2 and 7, Heinz as modified teaches the registering at the

terminal of each stored password once it has been used to log-on (Heinz, column 6,

lines 13-17).

10.   With regards to claims 3 and 8, Heinz as modified teaches the updating of

expendable passwords stored on the terminal device by transmitting a new set from the

server to the terminal (Heinz, column 6, lines 44-48 and Figure 3).

11.   With regards to claims 4 and 9, Heinz as modified teaches the automatic

ordering of a new set of passwords by the terminal to the server when all of the

passwords have been used (Heinz, column 6, lines 48-54).

12.   With regards to claims 5 and 10-11, Heinz as modified teaches a database of

passwords corresponding to different remote servers (Nielsen, column 3, lines 64-66)

and a means for selecting one of the set of passwords corresponding to the service

being accessed by the user for use in logging-in (Nielsen, column 4 line 57 – column 5

line 3).

13.   Claims 12-14, and 16-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Heinz US Patent No. 5,812,764 and Nielsen US Patent No 6,006,333

as applied to claim 6 above, and further in view of Sormunen et al US Patent No.

6,113,078.

14.   With regards to claim 12, Heinz as modified fails to teach the use of a wired

network using a telephone. Sormunen discloses a telecommunications network using a

telephone (Sormunen, column 6, lines 58-67). At the time the invention was made, it

would have been obvious to a person of ordinary skill in the art to utilize Sormunen's

method of using a wired telecommunications network because it offers the advantage of

being able to use email as a method of transmitting information (Sormunen, column 5,

lines 63-67).

15.   With regards to claims 13 and 14, Heinz as modified fails to teach the network

being a mobile network using GSM. Sormunen discloses a mobile GSM network using

GSM terminals (Sormunen, column 3, lines 12-31. At the time the invention was made,

it would have been obvious to a person of ordinary skill in the art to utilize Sormunen's

method of incorporating GSM terminals and networks because it offers the advantage of

providing enciphered transmissions and fast data transfer (Sormunen, column 3, lines 36-41).

16.   With regards to claims 16 and 17, Heinz as modified teaches a database of passwords corresponding to different remote servers (Nielsen, column 3, lines 64-66) and service identifiers and password names corresponding to the service being accessed by the user for use in logging-in (Nielsen, column 4 line 57 – column 5 line 3).

17.   With regards to claim 18, Heinz as modified teaches the updating of expendable passwords stored on the terminal device by transmitting a new set from the server to the terminal at the request of the terminal (Heinz, column 6, lines 44-48 and Figure 3), but fails to teach the use of short message service to send a request for a password. Sormunen discloses the use of short message service for use in requesting a password (Sormunen, column 3, lines 54-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Sormunen's method of requesting a password with short message service messages because it offers the advantage of encrypting the messages and prevents outsiders from deciphering the request or the returned passwords (Sormunen, column 3, lines 65-67).

Allowable Subject Matter

18.   Claim 15 is allowed.

Conclusion

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

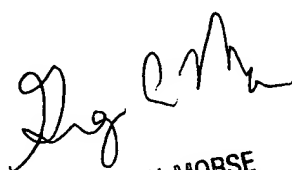than SIX MONTHS from the date of this final action.

20.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andrew L Nalven whose telephone number is 571 272

3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate

Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gregory Morse can be reached on 571 272 3838. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven

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